

CUSTOMER NO. 46900

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Attorney Docket No. McLellan 20

In re application of: Scott W. McLellan

Serial No.: 10/573,575

Group Art Unit: 2617

Filed: 03/27/2006

Examiner: Diego D. Herrera

Matter No.: 992.1559

Phone No.: 571-272-0907

For: Mobile Phone Comprising a Personal Locator Beacon Transmitter for Emergency Communications in an Area Where Mobile Phone Service Is Unavailable (As Amended)

PETITION TO REMOVE FINALITY OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition to remove the finality of the office action dated 01/05/2010.

In the office action dated 06/16/2009, the Examiner rejected then pending claims 8 and 16 under 35 U.S.C. § 102(b) as being anticipated by Hoke.

In Applicant's response dated 09/24/2009, independent claims 1 and 9 were amended to include the limitations of claims 8 and 16, respectively. Claims 8 and 16 were canceled. After the amendment, claim 1 became equivalent to previously pending claim 8 rewritten in independent form, and claim 9 became equivalent to previously pending claim 16 rewritten in independent form.

In the subsequent office action (dated 01/05/2010), independent claims 1 and 9 (equivalent to previously pending claims 8 and 16, respectively) were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoke in view of Taylor. Therefore, the Examiner introduced a new ground of rejection for pending claims 8 and 16, now presented as claims 1 and 9, respectively. Presumably, the Examiner did not and/or could not maintain the initial grounds of rejection for the two claims in question because Applicant's arguments with respect to the allowability of those claims over Hoke alone clearly established that the initial rejection was improper. It is therefore follows that the **improperness of the rejection over Hoke alone**, and not Applicant's amendment, **necessitated the new grounds of rejection**.

Since MPEP § 706.07(a) **explicitly prohibits** making the rejection final "where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed

during the period set forth in 37 CFR 1.97(c),” it is submitted that the finality of the office action dated 01/05/2010 is improper and should be withdrawn.

If the Commissioner determines that a fee is necessary for this petition, then authorization is hereby given to charge (or credit) **Deposit Account No. 50-0782** as required.

Respectfully submitted,

Date: 02/12/2010
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